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Attorney Docket No: 6553-0501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jeppesen
Serial No: 10/629,511
Filed: 07-29-2003

Examiner: Bunin, A.
Art Unit: 3743

Title: Method and Apparatus for Treating Obstructive Sleep Apnea Syndrome

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

VIA FAX: (571)273-8300

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

SIR:

Applicant submits this response to the Examiner's Office Action of 06/23/2005. The appropriate fee for a one month extension for response is submitted in the accompanying form PTO-2038.

Please take note that a preliminary amendment correcting the specification and presenting amended claims is being filed concurrently with this Response.

Applicant provisionally elects Group III on which claims 18-32 and new claim 39 read. With respect to the patentably distinct species of the claimed invention within Group II, (i.e. claims 12 and 14), this no longer exists. Claims 12 and 14 have been canceled and the elements of claim 12 have been combined with independent claim 11. Newly added claim 38 is drawn to Group I.

The requirement for election is traversed. Pursuant to 37 CFR§1.143, reconsideration of the restriction requirement is requested and based upon the following:

A. The pending claims have been classified by the examiner to fall into one of Groups I, II, III, or IV and each group falls within the same class and subclass (i.e. class 128, subclass 848).

Inventions of Group I and Group III; and Group I and Group IV are related as combination and subcombination. The examiner cites MPEP §806.05(c) as the basis for restriction. However, this section states that to support a requirement for restriction, separate classification, status or field of search are necessary. MPEP §808.02. Since each Group falls within the same class and subclass, applicant believes restriction was improper and requests the examiner to reconsider his position.

Additionally, with respect to Groups I and III, claim 1 has been amended to include positive airway pressure (claim element i) and an elongated slide (claim element a), thus the distinctions the examiner focused upon are no longer present.

It is respectfully submitted in view of applicant's amendment of claim 1 and taking into consideration MPEP §808.02, the examiner withdraw his restriction requirement with respect to Groups I, III, and IV.

B. Inventions of Group I and Group II are related as process and apparatus. The examiner references MPEP §806.05(e) as the basis for restriction, contending that the method including upper and lower dental arches in elastomeric material via a snap fit (Group I) are not included in the claims pertaining to the device in Group II. Therefore, the device used to perform the method of Group I could be different from the device claimed in Group II.

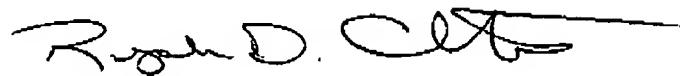
Applicant believes this restriction is also improper because the apparatus described in the method claims of Group I is not materially different from the device claims of Group II.

The "snap-fit" the examiner focused upon describes an engagement condition between a patient's upper and lower teeths and the elastomeric material of the oral appliance. (Specification page 6, lines 1-7). It is submitted this condition does not represent materially different devices. Both Groups include a single-piece, dual arch airway orthotic, PAP Tubing Retention Platforms, PAP tubing holes and use of elastomeric material. The substantial similarity of many of the claim elements between Groups I and II negate that the devices are materially different; further, the class/subclass between Group I and Group II are the same. The MPEP does not require that the devices be identical. Therefore, devices having substantial similarities should not be categorized as materially different. On this basis, the examiner is asked to reconsider and withdraw his restriction requirement.

C. With respect to the election of species in Group II, applicant has canceled claims 12 and 14; combining dependent claim 12 with independent claim 11. Since more than one species is no longer claimed, applicant believes election of a species is no longer necessary. However, if an election is required, applicant elects claim 12 which has been canceled by preliminary amendment and is now embodied in currently amended independent claim 11.

Respectfully submitted,

Dated: August 3, 2005



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